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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,383	11/04/2003	Jean-Francois Savouret	RICL-110 (69769-011)	5818
35893	7590	03/02/2006	EXAMINER	
GREENBERG TRAUIG, LLP ONE INTERNATIONAL PLACE, 20th FL ATTN: PATENT ADMINISTRATOR BOSTON, MA 02110			KEYS, ROSALYND ANN	
			ART UNIT	PAPER NUMBER
			1621	
DATE MAILED: 03/02/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/700,383

Applicant(s)

SAVOURET ET AL.

Examiner

Rosalynd Keys

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 14-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-13, 26 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-27 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 1-27 are pending.

Claims 1-8, 10-13, 26 and 27 are rejected.

Claims 9 and 14-25 are withdrawn from consideration.

### ***Election/Restrictions***

2. This application contains claims 9 and 14-25 drawn to an invention nonelected without traverse in the response filed May 2, 2005. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-8, 10-13, 26 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 1 is indefinite because there is no substituent P3' in the chemical structure of formula I. Claims 2-8, 10-13, 26 and 27 are indefinite because they depend from an indefinite claim. Ex parte Cordova, 10 U.S.P.Q.2d 1949, 1952 (P.T.O. Bd. App. 1989).
6. Claims 13, 26 and 27 are indefinite because of the use of the term "said". It is unclear what the term said is referring to. Claims 13, 26 and 27 are further unclear because of the limitations "dosage" and "/day". Dosage and /day (per day) are actions to be performed during

Art Unit: 1621

an administration step for a method, However, claims 13, 26 and 27 appear to be directed to a pharmaceutical composition. Claim 26 is further unclear because of the use of the term "especially". Claim 27 is further unclear because of the use of the phrase "in particular".

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-5, 10-13, 26 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Suga (US 5,530,030), for the reasons given in the previous office action mailed June 21, 2005.

9. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Letcher, R. M. (Org. Magn. Reson., Vol. 16, No. 3, 1981, pages 220-223), for the reasons given in the previous office action mailed June 21, 2005.

10. Claims 1, 2 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Moylan et al. (MCLC S& T, Section B: Nonlinear Optics, Vol. 8, No. 1, 1994, pages 69-78), for the reasons given in the previous office action mailed June 21, 2005.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 1621

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

13. Claims 1-5, 10-13, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masahiko et al. (JP 51-136826), for the reasons given in the previous office action mailed June 21, 2005.

### ***Response to Amendment***

#### **Claim Objections**

14. The objection to claims 7 and 11 is withdrawn due to the amendment to said claims filed December 23, 2005.

#### **Claim Rejections - 35 USC § 112**

15. The previous rejection of claims 13 under 35 U.S.C. 112, second paragraph, is withdrawn due the amendment to said claim filed December 23, 2005.

### ***Response to Arguments***

16. Applicant's arguments filed December 23, 2005 have been fully considered but they are not persuasive.

#### **Rejection of claims 1-5, 10-13, 26 and 27 under 35 U.S.C. 102(b) as being anticipated by Suga (US 5,530,030)**

17. The Applicants argue that Suga fails to teach a substituted hydroxyl group at the para position. This argument is not persuasive because the claimed invention is not limited to the OH group being at the para position. The claim also includes a meta substituted OH group (see claim 1, wherein R3, R5, R3' and R5' are identical or different and represent OH).

Art Unit: 1621

18. The Applicants argue that moreover, there are two functional groups tied to a ring of benzene in position 1 and 3 in Table 1, compound 7, hydroxy group. This argument is not persuasive because claim 1 discloses that R3' is identical or different and represent OH.

The Examiner believes that Suga does anticipate the instant claims.

For the above reasons, the rejection of claims 1-5, and 10-13 under 35 U.S.C. 102(b) as being anticipated by Suga (US 5,530,030) is maintained.

Rejection of claims 1-7 under 35 U.S.C. 102(b) as being anticipated by Letcher, R. M. (Org. Magn. Reson., Vol. 16, No. 3, 1981, pages 220-223)

19. The Applicants argue that "claim 1 recites a stilbene derivative and the symmetrical derivatives of the compound. In contrast, Letcher R.M. fails to disclose each and every claim element. Rather, if the Examiner may note, Letcher R.M. does not include symmetrical derivatives in its description. " This argument is not persuasive because the claims are not limited to symmetrical derivatives. Claim 1 also includes the compound having the claimed formula I, wherein R3 and R5 are Cl; R4, R3' and R5' are H, and R4' is Cl. This compound is trans-3,4',5'-trichlorostilbene, and is taught by Letcher (see document XP-002232735, supplied by Applicants or page 222 of the original article in Organic Magnetic Resonance, Vol. 16, No. 3, 1981, which is being supplied with this office action ).

The Examiner believes that Letcher, R. M. does anticipate the instant claims.

For the above reason, the rejection of claims 1-7 under 35 U.S.C. 102(b) as being anticipated by Letcher, R. M. is maintained.

Rejection of claims 1, 2 and 8 under 35 U.S.C. 102(b) as being anticipated by Moylan et al. (MCLC S& T, Section B: Nonlinear Optics, Vol. 8, No. 1, 1994, pages 69-78)

20. The Applicants have put forth arguments regarding intended use or property and cited a case In re Perason, 494 F.2d, 1399. Firstly, there is no intended use or property disclosed in

Art Unit: 1621

claims 1, 2 and 8. Thus, any arguments of such are irrelevant. Nonetheless, even if the instant claims contained the intended use or property, Moylan et al. would still anticipate them because the intended use or property does not result in a structural difference between the stilbene compound disclosed by Moylan et al. and the instant stilbene compound. See MPEP 2111.02 and MPEP 2131. Secondly, a search in [www.bna.com](http://www.bna.com) did not retrieve a case by the name of In re Perason. Thus, the Examiner cannot comment on the merits of that case at this time.

The Examiner believes that Moylan et al. do anticipate the instant claims.

For the above reasons, the rejection of claims 1, 2 and 8 under 35 U.S.C. 102(b) as being anticipated by Moylan et al. is maintained.

Rejection of claims 1-5, 10-13, 26 and 27 under 35 U.S.C. 103(a) as being unpatentable over Masahiko et al. (JP 51-136826)

21. In the Applicants arguments regarding Masahiko et al. they make reference to Suga. The Examiner assumed that the Applicants meant Masahiko et al. Thus, the Examiner will only refer to Masahiko et al. in response to these arguments. The Applicants argue that Masahiko et al. fail to teach a substituted methoxy group at the para position and instead teach a substituted methoxy group at the meta position. This argument is not persuasive because the claims are not limited to a methoxy group in the para position, but also teach that methoxy can be in the meta position (see claim 1, wherein R3, R5, R3' and R5' are identical or different and represent O-alkoxy).

22. The Applicants argue that moreover, there are two functional groups tied to a ring of benzene in position 1 and 3 at compound 7 on page 186. This argument is not persuasive because claim 1 discloses that R3 is identical or different and represent O-alkoxy.

The Examiner believes that the instant claims are unpatentable over Masahiko et al.

Art Unit: 1621

For the above reasons, the rejection of claims 1-5, and 10-13 under 35 U.S.C. 103(a) as being unpatentable over Masahiko et al. (JP 51-136826) is maintained.

### ***Conclusion***

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosalynd Keys whose telephone number is 571-272-0639. The examiner can normally be reached on M-W & F 4-10pm; H 5:30am-5pm; Sat 8am-1pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 1621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Rosalyn Keys  
Primary Examiner  
Art Unit 1621

February 24, 2006